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Response Under 37 CFR 1.116
Expedited Procedure
Examining Group Art Unit 2172

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of   Atty. Docket

RAYMOND KRASINSKI   US000284

Serial No. 09/699,609   Group Art Unit: 2172

Filed: OCTOBER 30, 2000   Examiner: A. KINDRED

TITLE: METHOD AND APPARATUS FOR COMPRESSING TEXTUAL DOCUMENTS

Commissioner for Patents
P.O. Box 1450   **RECEIVED**
Arlington VA   22313-1450

                                               AUG 0 7 2003

            RESPONSE UNDER 37 C.F.R. 1.116   Technology Center 2100

Sir:

        This responds to the final Office Action of June 26, 2003.
Reconsideration and allowance of the application in view of the
remarks to follow are respectfully requested.

        Claims 1-21 are pending in this application of which Claims 1,
11, 18, 19, 20, and 21 are independent claims.

        In the Office Action, Claims 1-6, 9-15, and 18-21 were rejected
under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No.
5,991,713 to Unger ("Unger") in view of U.S. Patent No. 5,999,949 to
Crandall ("Crandall"). Claims 7-8 and 16-17 were rejected under 35

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U.S.C. §103(a) as unpatentable over Unger and Crandall in view of U.S.

Patent No. 6,175,820 to Dietz ("Dietz").[1]

Focusing on the rejection of Claim 1 in the Office Action based

on Unger and Crandall, the Office Action acknowledges that Unger fails

to teach the Claim 1 recitation of "wherein said document before and

after the compressing step is in a given file format". Thus, the

Office Action appears to rely on Crandall for purportedly supplying

this missing element. However, the Office Action does not explicitly

state this, nor does it analyze how Unger would be modified in view of

Crandall to provide all of the recitations of Claim 1. Thus, the

Office Action fails to present a prima facie case of obviousness.

MPEP 706.02(j)

In addition, in view of what Crandall appears to fairly disclose,

the combination of Unger and Crandall does not in fact present a prima

facie case of obviousness: As previously noted in the Amendment

mailed February 20, 2003, Unger teaches a system that takes a file

having a first file format, such as HTML, compresses textual data from

the file, and results, after compilation, in a second file having a

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[1] The Examiner confirmed by telephone on August 1, 2003 that the
correct patent number for Crandall is U.S. Patent No. 5,999,949
(i.e., the citation to U.S. Patent No. 5,991,949 in the Office
Action is a typographical error). Also, Applicant does not appear
to have received a copy of the PTO-892, but subsequently confirmed
with the Examiner that only Crandall was newly cited. It is
respectfully requested that the Examiner provide a copy of PTO-892
with the next communication.

second file format. Crandall teaches compressing and decompressing a text file (such as an ASCII file or the text portion of an HTML file) by creating a number of dictionary files and a word index, among other things. Because Unger already compresses textual data before compilation, Crandall's text compression does not provide additional teaching to Unger in this regard.

Thus, without conceding that such a combination is proper, modifying Unger in view of the text compression taught by Crandall would only result in what is already disclosed in Unger alone: A system that takes a file having a first file format, such as HTML, compresses textual data from the file, and results, after compilation, in a second file having a second file format. The second file format would still be analogous to that shown in Fig. 7 (ref. no. 52) of Unger.

Because Crandall adds nothing to Unger that isn't already there, the remarks given in the prior Amendment regarding the disadvantages of Unger apply equally to the combination of Unger and Crandall. For example, due to the change of format, the combination of Unger and Crandall would still require an intermediate program or a separate proxy server to translate the compiled document before it is readable in the first file format. In addition, the tags are altered in the file compressed file format of Unger and a correspondence table is

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created to preserve the relationship between the tags and corresponding text and objects.

Thus, without conceding that such a combination is proper, the combination of Unger and Crandall fails to provide (at least) the Claim 1 recitation of "wherein said document before and after the compressing step is in a given file format". Accordingly, the combination of Unger and Crandall fails to present a prima facie case of obviousness with respect to Claim 1. See, e.g., MPEP 2143.03.

Finally, even supposing hypothetically (but not conceding) that the combination of Unger and Crandall did result in the Claim 1 recitation of "wherein said document before and after the compressing step is in a given file format", the rationale given for combining Unger and Crandall in the Office Action is improper. The Office action states that such a combination would have been obvious "because using the [Claim 1 recitation] of "wherein said document before and after the compressing step is in a given file format", would have given those skilled in the art the tools to ability [sic] to process compressed and uncompress[ed] data regardless [of] the data format" and that "[t]his gives users the advantage of processing compressed/uncompressed data faster". (Office Action, ¶3 at p. 2) Thus, the only rationale given in the Office Action for combining Unger and Crandall is that the Claim 1 recitation of "wherein said document before and after the compressing step is in a given file

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format" would have provided certain purported benefits. This is not a

proper rationale for combining the teachings of Unger and Crandall.[2]

See MPEP 2143.01.

For at least the above-noted reasons, Claim 1 is patentably

distinct from the combination of Unger and Crandall. Independent

Claims 11, 18, 19, 20, and 21 are allowable for at least analogous

reasons. Without conceding the patentablility per se of dependent

Claims 2-10 and 12-17, they are allowable at least by virtue of their

dependencies on their respective independent claim. Accordingly,

reconsideration and allowance of all claims in the Application,

namely, Claims 1-21, is respectfully requested.

The Applicant has made a diligent and sincere effort to place

this application in condition for immediate allowance and notice to

this effect is earnestly solicited.

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[2] Apart from not providing a proper rationale, the statement of
benefits in the Office Action are also unclear. That is, the
statements "would have given those skilled in the art the tools to
ability [sic] to process compressed and uncompress[ed] data
regardless [of] the data format" and that "[t]his gives users the
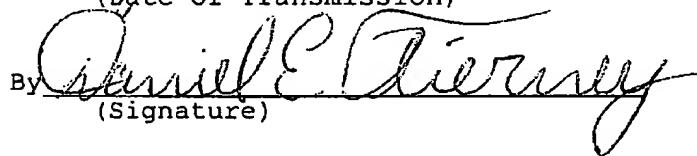advantage of processing compressed/uncompressed data faster" are
unclear.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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